

REMARKS

This communication is a full and timely response to the non-final Office Action dated September 8, 2005 (Paper No./Mail Date 0805). By this communication, claims 10 and 15-18 have been canceled without prejudice or disclaimer of the underlying subject matter and claims 1-9 and 11-14 have been amended.

Claims 1-9 and 11-14 have been amended to improve idiomatic English and form. No new matter has been added.

Claims 1-9 and 11-14 are pending where claim 1 is independent.

Drawing Objections

Figure 6 was objected to for allegedly including a reference character that is not described in the disclosure. In particular, the Office Action alleges that “REPORT X ADDRESS OF X MASK-ADDRESS STORAGE UNIT TO BUFFER UNIT OF EACH REDUNDANT BLOCK” is not supported in the specification. Applicant respectfully traverses this objection.

At paragraph [0084]¹, the instant application states, “[i]f the X-address storage location included in the X-address storage unit 421 as a location pointed to by a combination of the pointer of the lower shift register and the pointer of the upper shift register contains an X address, the X address is reported to the buffer units 41-1 to 41-4.” Where buffer units 41-1 to 41-4 “carry out the repair search described earlier in order to store only fewest possible pairs of X and Y addresses required for determining redundant lines to be used to repair abnormal memory cells for 4 redundant blocks 11.” See paragraph [0074]. These statements provide evidence that the reference character in Figure 6 is, in fact, supported by the disclosure. Accordingly, Applicant respectfully requests that the objection to Figure 6 be withdrawn.

The drawings were objected to under 37 CFR 1.83(a) for failing to show every feature recited in the claims. Applicant respectfully traverses this rejection. Applicant has provided a claim listing below with citations that identify portions of the specification and drawings that support the corresponding element. For at least this reason, Applicant respectfully submits that each feature in the drawings is supported in the specification. Accordingly, Applicant requests that the objection to the drawings be withdrawn.

¹ See corresponding U.S. Patent Application Publication No. 2005-0007841.

Rejections Under 35 U.S.C. §112

Claims 1-18 were rejected under 35 U.S.C. §112, first paragraph as non-enabled by the specification. Applicant respectfully traverses this rejection. However, in an effort to expedite prosecution Applicant has canceled claims 10 and 15-18 without prejudice. Further, Applicant has provided an Appendix that includes a claim listing having citations to the specification and drawings where support for the recited element is found. For at least this reason, Applicant respectfully submits that claims 1-9 and 11-14 are enabled by the specification.

In the event, a subsequent Office Action takes the position that pending claims 1-9 and 11-14 are still not enabled by the specification, Applicant notes that it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (1971).

Please note that section 112 requires only an objective enablement; the invention needs to be sufficiently disclosed through illustrative examples or terminology to teach those of ordinary skill in the art how to make and how to use the invention as broadly as it is claimed. *In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). See also M.P.E.P §§2164.01, 2164.04. “The applicant does not have to utilize any particular form of disclosure to describe the subject matter claimed.” *In re Alton*, 76 F.3d 1168, 1172, 37 USPQ2d 1578, 1581 (Fed. Cir. 1996).

The MPEP provides a number of factors that must be considered when determining whether there is sufficient evidence to support whether the enablement requirement is satisfied. Some factors include:

- The breadth of the claims
- Nature of the invention
- State of the prior art
- Level of one of ordinary skill
- Level of predictability in the art
- Amount of direction provided by the inventor

MPEP states that all of these factors must be considered, and any conclusion of non-enablement must be based on the evidence as a whole. *See* §2164.01(a).

Furthermore, the MPEP states that a specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. §112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. *See* §2164.04. “It is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.” In re Marzocchi 439 F.2d at 224, 169 USPQ at 370.

In presenting the enablement rejection, the Examiner should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. This can be done by making specific findings of fact, supported by the evidence, and then drawing conclusions based on these findings of fact. For example, doubt may arise about enablement because information is missing about one or more essential parts or relationships between parts that one skilled in the art could not develop without undue experimentation. In such a case, the examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation. *See* §2164.04.

Accordingly, Applicant respectfully requests that the rejection of claims 1-9 and 11-16 under §112, first paragraph be withdrawn. Furthermore, because no prior art rejection has been applied to the claims, Applicant respectfully requests that these claims be allowed. However, in the event a subsequent Office Action includes a prior art rejection, that Office Action must be a non-final Office Action.

Conclusion

Based on at least the foregoing amendments and remarks, Applicant submits that claims 1-9 and 11-14 are allowable, and this application is in condition for allowance. Accordingly, Applicant requests a favorable examination and consideration of the instant application. In the event the instant application can be placed in even better form, Applicant requests that the undersigned attorney be contacted at the number listed below.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. SON-2998 from which the undersigned is authorized to draw.

Dated:

Nov. 30, 2005

Respectfully submitted,

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